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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,460

08/17/2005

Volker Beckord

P1993

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02/05/2009

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EXAMINER

BRAYTON, JOHN JOSEPH

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

02/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,460	Applicant(s) BECKORD, VOLKER	
	Examiner John Brayton	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of Claims

1. Claims 1-20 are pending.

Drawings

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention (drawings are referenced in the specification and are contained in the disclosure of PCT/EP2003/014742). Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Claim Objections

3. Claims 13, 14 and 17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim, it is a dependant claim that depends upon another multiple dependant claim. See MPEP § 608.01(n). Accordingly, the claims 13, 14, and 17 have been treated as if dependent upon claim 1.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1, 6, 9, 13, 15, 17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Regarding claims 1, 6, 9, 13, 15, 17, 19, and 20, the phrase "in particular, or particularly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear from claim 1 whether it is a claim for a product or a claim for a process. If intended to be a product by process the Examiner rejects claim 1 because it does not the process in a step wise manner. However, it appears from claim 1 that the Applicant has intended to claim a product. Therefore the Examiner has treated claim 1 as a product claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6, 7, 9, 10, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa (JP 11-276948).

Regarding claim 1, Ogawa teaches a masking means for masking of a longitudinally extended edge area of a vehicle body or an appliance housing during a coating procedure, in particular a paint or conservation process,

wherein the development is as longitudinal high-grade flexible extruded synthetic profiles (Abstract) with a continuous longitudinal cavity and a slot in the outer contour leading into the cavity, whose boundary edges (31) are elastically pre-tensioned to each other (Fig. 6 and 7).

A claim limitation will be presumed to invoke 35 U.S.C. §112 ¶ 6th only if the following three part analysis is met. 1) The claim limitation must use the phrase “means for” or “step for”; 2) the “means for” or “step for” must be modified by functional language; and 3) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function. See MPEP § 2181.

Regarding claim 1, “masking means for” does not meet the three part analysis set out above, because it is modified by sufficient structure, “masking”, and therefore does not invoke 35 U.S.C. §112 ¶ 6th.

Regarding claim 2, Ogawa teaches masking means according to claim 1, wherein the synthetic profile design is in the cross-section essentially circular, elliptical, oval or slanted oval and as synthetic pipe with longitudinally alternating first portions of greater rigidity and lower elasticity (21, 22) and second portions of lower rigidity and greater elasticity (20).

Regarding claim 3, Ogawa teaches a masking means according to claim 2, wherein the synthetic profile design is formed, via a rotation extrusion procedure, with longitudinally alternating first portions of greater rigidity (21, 22) and lower elasticity and second portions of lower rigidity and greater elasticity (20).

The method of forming the device is not germane to the issue of patentability of the device itself. Therefore this limitation has not been given patentable weight.

Regarding claim 4, Ogawa teaches the synthetic profile in the slot area is essentially retracted V or U-shaped such that it automatically aligns itself on the longitudinally extended edge area when slid onto it (Fig. 7).

Regarding claim 6, Ogawa teaches the synthetic profile in the cross-section essentially has a U-shape (Fig. 7).

Regarding claim 7, Ogawa teaches the synthetic profile in cross-section has the form of a slanted "U" with a cavity expanding on the basis of the "U" for the elastically-arrested attachment on the edge area with different material thicknesses (Fig. 7 and 9).

Regarding claim 9, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

In light of *Gardner*, Ogawa teaches the cavity has a maximum width in the range of 3 to 12 mm and the continuous slot has a minimum free width of less than 1 mm, especially of 0.2 mm or less, for the elastically-arrested attachment on an edge area, with a minimum material thickness of roughly 1 mm and a maximum material thickness within the range of 2.5 to 6 mm.

Regarding claim 10, Ogawa teaches the design is with high-grade temperature-resistant plastic (pg. 3, [0012-0013]). The Examiner takes the position that the following language is a functional recitation “functioning at least 175 degree C for at least 25 min and also at least 155.degree. C. for at least 75 min” and as such has not been given patentable weight because it is narrative in form.

In order to be given patentable weight, a functional recitation must be express as “mean” for performing the specified function, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. Here, Applicant attempts to invoke means for language “masking means”, however, as cited above in the rejection of claim 1 said language fails the test set out under 35 U.S.C. 112 6th paragraph.

Regarding claim 17, Ogawa teaches a coating process for coating a coating substrate, in particular a vehicle body (car pillar, Abstract) having a free edge area, with a coating means via a coating-spray stream or under a coating atmosphere, under coverage of the edge area, wherein the edge area is covered with a masking means according to one of the above claims (Abstract of Ogawa).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 1 above in view of Beeney (US 2,981,786).

Regarding claim 5, Ogawa does not explicitly teach longitudinally equidistant incisions are provided that are diagonal to the long axis, which cut through the profile side at the large part of the level of the synthetic profile, for the formation of profile tabs joined together opposite the slot that tilt against each other but still essentially cover each other in areas of tight bending.

Beeney teaches longitudinally equidistant incisions are provided that are diagonal to the long axis, which cut through the profile side at the large part of the level of the synthetic profile, for the formation of profile tabs joined together opposite the slot that tilt against each other but still essentially cover each other in areas of tight bending (Fig. 1-5).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing teach longitudinally equidistant incisions are provided that are diagonal to the long axis, which cut through the profile side at the large part of the level of the synthetic profile, for the formation of

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profile tabs joined together opposite the slot that tilt against each other but still essentially cover each other in areas of tight bending, because it would increase the flexibility of the tube or pipe.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 1 above in view of Barredo (EP 1 217 282).

Regarding claim 8, Ogawa does not explicitly teach the wall of the synthetic profile exhibits continuous, closed cavities extending in longitudinal direction, for increasing the flexibility and decreasing the amount of material used.

Barredo teaches a wall of a synthetic profile exhibits continuous, closed cavities (2) extending in longitudinal direction (Fig. 3), for increasing the flexibility and decreasing the amount of material used.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing closed cavities on the all of the synthetic profile because it would reinforce the structure of the double walled pipe (col. 3, [0014]).

14. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 1 above, and further in view of Liu (US 4,536,538).

Regarding claim 11, Ogawa teaches masking means wherein reinforcement is via filler material, but does not explicitly teach a quantity between 0.1% and 40%.

Liu teaches adding approximately 5 to 30 weight % glass fiber as filler material for reinforcement in thermoplastics (col. 5, ln. 18-30).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing a filler material in a quantity between 0.1% and 40%, because it would reinforce the material.

Regarding claim 12, Ogawa teaches the design is with a thermoplastic elastomer or polyamide (Abstract).

Regarding claim 13, Ogawa does not explicitly teach a considerable quantity, in particular more than 75% and more particularly 90%, is of recycled plastic.

It is well known to use recycled materials. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use recycled materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

15. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 1 above in view of Boyle (GB 2,288,349).

Regarding claim 14, Ogawa does not explicitly teach a bracket or handle.

Boyle teaches a masking arrangement with a masking means according to one of the above claims and a bracket attachable (5) to the masking means (3) for improved adhesion on the edge area (Fig. 6).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing a bracket because it would allow the mask to be moved along the area to be masked (pg. 4, ln. 15-30).

Regarding claim 15, Ogawa does not explicitly teach a bracket or handle.

Boyle teaches the bracket exhibits a contact and holding section in its inner contour (5) on the outer contour of the masking means (3) as well as handling section connected with this, particularly via a web. The Examiner takes the position that the handle could be attached via welding or an adhesive each of which attached the two structures together using a web of material.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing a bracket with a handling section because it would allow the mask to be handled with the handle.

Regarding claim 16, Ogawa does not explicitly teach a bracket or handle.

Boyle teaches the contact and holding section and/or the handling section of the bracket (5) essentially exhibits circular, elliptical or oval cross-section.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Ogawa by providing a circular handle because it would make the handle easier to handle.

16. Claims 18-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 17 above, and further in view of Hermann et al (US 6,025,033).

Regarding claim 18, Ogawa does not explicitly the coating of a dip primer coated vehicle body.

Herrmann teaches a procedure for the painting of a dip primer coated vehicle body or an appliance housing via a paint-spray stream (col. 6, ln. 30-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Ogawa by painting of a dip primer coated vehicle with a paint spray stream because one skilled in the art would have only expected predictable results.

Regarding claim 19, Ogawa does not explicitly teach a process carried out after a painting process.

Hermann teaches a process, in particular which is directly carried out after a painting process, for the conservation of a vehicle body or appliance housing, in particular an automobile body or an aircraft fuselage or ship's hull, via a conservation-spray stream (col. 6, ln. 30-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Ogawa by painting of a vehicle body with a paint spray stream directly after a painting process, because it would be more economical to do one painting process after the other.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa as applied to claim 17 above, and further in view of Nestell et al (US 6,398,396).

Regarding claim 20, Ogawa teaches the process is embodied as a coating process, but does not explicitly teach a vacuum coating process, in particular vacuum sputter or sputter processes, for creation of a thin protective or functional coating on the coating substrate.

Nestell teaches a sputtering process for the creation of a thin protective coating on the surface of lens used in a car (col. 7, ln. 60-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Ogawa by a sputtering process to create a thin protective or functional layer, because it protect the substrate from the elements with a thin protective layer (col. 7, ln. 60-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Brayton whose telephone number is (571)270-3084. The examiner can normally be reached on 7:30 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nam X Nguyen/
Supervisory Patent Examiner, Art Unit 1753

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/J. B./

Examiner, Art Unit 1795